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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,249	07/08/2003	Edward L. Rapp	02280.003720.	8220
5514 7590 08/17/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
PRATT, HELEN F				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/17/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD L. RAPP, JAMIE TROY, JEANNETTE DIDO,
DOUGLAS MANN, THOMAS COLLINS, KEVIN RABINOVITCH,
RALPH LEE, NEIL WILLCOCKS, ROBERT BOUSHELL, RALPH
JEROME, TIAGO O. RODRIGUES, JOHN M. KAISER, and
IVONNE E. NILL

Appeal 2009-002865
Application 10/615,249
Technology Center 1700

Decided: August 17, 2009

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and,
JEFFREY T. SMITH., *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-4, 6-8, and 10-24.¹ (App. Br. 1). We have jurisdiction pursuant to 35 U.S.C. § 6(b).^{2, 3}

We REVERSE.

THE INVENTION

Appellants' claimed invention is directed to a food product categorized as an energy bar. Claim 1, reproduced below, is representative of the subject matter on appeal.⁴

1. An energy bar having a mean hedonic score for consumer acceptability of at least about 5.2,
wherein said energy bar has
about 15 to about 45 g of carbohydrates,
about 1 to about 4.5 g of fortification components,
about 8 to about 40 g of protein,
about 3 to about 8 g of fat,
about 150 to about 300 calories, and
a moisture content of less than about 15% by weight, based on a
55 g serving size,
wherein said carbohydrates are selected from the group consisting
of starch, sugar, gels, syrups, honey, molasses, and
combinations thereof,
said fortification components are selected from the group
consisting of vitamins, minerals, and combinations thereof,
said protein is selected from the group consisting of whey protein,
milk protein, egg protein, casein, peanut flour, nut meats,
vegetable protein, and combinations thereof, and

¹ Claims 5 and 9 have been canceled. (App. Br. 1).

² In this decision we have considered Appellants arguments presented in the Briefs, filed December 21, 2007 and April 28, 2008.

³ An oral hearing for this appeal was held on June 23, 2009.

⁴ For purposes of clarity, the format of the claim has been modified from the appearance in the Appeal Brief.

said fat is selected from the group consisting of chocolate, peanut butter, fat substitutes, vegetable fats, tropical fats, animal fats and combinations thereof.

THE REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kelly	4,055,669	Oct. 25, 1977
Froseth	6,592,915 B1	Jul. 15, 2003
Avera	3,615,590	Oct. 26, 1971

Appellants appeal the following rejections:

Claims 1-4, 6-8, and 10-24 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-4, 6-8, and 10-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kelly, Froseth and Rombauer.⁵

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kelly, Froseth Rombauer and Avera.

The 35 U.S.C. § 112, 1st Paragraph, Rejection

The dispositive issue before us is: have Appellants shown the Examiner reversibly erred in concluding that the Specification does not provide sufficient enabling description of the claim feature, “fortification components are selected from the group consisting of vitamins, minerals” as required by 35 U.S.C. § 112, first paragraph? We answer this question in the affirmative.

⁵ The Examiner has indicated that claims 11 and 12 are now included in this rejection. (Ans. 10). Appellants requested that the appeal be maintained. (Reply Brief cover page).

The Examiner concluded the feature, “about 1 to about 4.5 g of fortification components, does not reasonably provide enablement for 1 to about 4.5 g of vitamins and minerals” as recited in claim 1. (Ans. 3). Appellants contend the Specification provides sufficient description to enable all features of the claim (App. Br. 10).

We agree with the Appellants, the Specification, paragraph [0016], expressly exemplifies vitamins and minerals as fortification components. The Specification discloses the amount of fortification components in the energy bar to be about 1 g to about 4.5g. (Spec. [0042]). The decision of the Examiner is reversed.

The 35 U.S.C. § 103(a) Rejections

ISSUE

The dispositive issue before us is whether the Examiner has reversibly erred in not considering the rebuttal evidence along with the facts on which the conclusion of prima facie obviousness was reached. We answer this question in the affirmative. Therefore, we REVERSE.

“After a prima facie case of obviousness has been made and rebuttal evidence submitted, all the evidence must be considered anew.” *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990)) (citing *In re Piasecki* 745 F.2d 1468, 1472 (Fed. Cir. 1984), (quoting *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976)); *Piasecki*, 745 F.2d at 1472 (“Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with facts on which the earlier conclusion was reached, not against the conclusion itself.”) (quoting *Rinehart*, 531 F.2d at 1052); accord *In re Piasecki*, 745 F.2d at 1472-73 (quoting *Rinehart*, 531 F.2d at

1052) (“appellants submitted extensive evidence of peer recognition, long-felt need, and commercial interest”; *see also* MPEP § 716.01(d).

In support of the nonobviousness position, Appellants proffer two Declarations (I and II) under 37 C.F.R. § 1.132 by Edward L. Rapp, both signed on May 8, 2006 (Appendix C and D of the Brief).

According to Appellants, the Rath Declaration I (Appendix C) provides expert opinion regarding the cited references and the Rath Declaration II (Appendix D) demonstrates evidence of long-felt need, and commercial success. (App. Br. 19-20, 23-24 and 28-29; Reply Br. 21-26).

While it appears (Ans. 11-14) that the Examiner has considered the merits of the Rath Declaration I, the same cannot be said for the Rath Declaration II. Regarding Rath Declaration II the Examiner states:

Appellants argue that the claims are not obvious in light of objective indicia such as long felt need, etc. However, the claimed composition and process has been shown and would have been obvious to make such a product as shown above.
(Ans. 16)

The Examiner's response to Rath Declaration II is largely dismissive. In fact, even though Appellants' Briefs place extensive reliance on the Declaration evidence to overcome the *prima facie* case, the Examiner's Answer never addresses it. This is improper. Whether the claimed invention would have been obvious cannot be determined without considering evidence attempting to rebut the *prima facie* case. *In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007)(“The claimed composition cannot be held to have been obvious if competent evidence rebuts the *prima facie* case of obviousness. By failing to consider the submitted evidence, the Board thus committed error.”). Since the Examiner did not consider the

submitted evidence, the rejection cannot be sustained. The decision of the Examiner is reversed.

For the foregoing reasons, the rejections of claims 1-4, 6-8, and 10-24 under 35 U.S.C. § 103(a) are reversed.

ORDER

The Examiner's decision rejecting claims 1-4, 6-8, and 10-24 is reversed.

REVERSED

tc

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